



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/360,805	07/23/99	CLUM	BP-157

HM12/1024

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HOLLINDER  
EXAMINER

ART UNIT

PAPER NUMBER

10/24/00

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/360,805

Applicant(s)

CLUM ET AL.

Examiner

Gary E Hollinden, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 May 2000.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 16-63 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

This Office Action is a request for reconsideration filed on May 22, 2000. Currently, Claims 16-63 are pending in this application.

The reissue oath / declaration filed with application is considered defective for reasons of record stated in the Office Action dated February 22, 2000.

Applicant's arguments filed on May 22, 2000 have been fully considered but they are not deemed to be persuasive. While not contesting that the newly added claims are drawn to different inventions from the original patent, Applicant asserts that it is permissible<sup>1</sup> to add claims to other inventions so long as no restriction requirement was made in the original patent. Applicant cites *In re Watkinson*<sup>2</sup> in support of this position. However, *Watkinson* is not on point because a restriction requirement was made and error was held to be not correctable. The correct test was set forth in *In re Mead*<sup>3</sup> which stated that the entire disclosure must be considered when determining what Applicant intended to claim and whether the invention now claimed is directed to a different invention (which would not be a correctable error) or some embodiment of the earlier claimed invention (which would be a correctable error). In the instant case, it is clear that the instant claims are not directed to a different embodiment of the original invention since:

1) They are directed to a process of making a composition rather than a composition *per se*.

2) The starting materials of the instant process are not the same as the materials set forth in the original compositions claims since the original composition only utilized certain vitamin A derivatives and further required a chelating agent and a water soluble antioxidant while the instant process requires no chelators or antioxidants and broadly claims any retinoid.

3) The instant process requires the presence of argon which was not a part of the original claimed invention.

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<sup>1</sup>i.e. that the addition of such claims is an correctable error for a reissue.

<sup>2</sup>14 USPQ 2d 1407 (CA FC 1990).

<sup>3</sup>198 USPQ 412 (CA FC 1978). Note that this case cited *In re Rowland*, cited by Applicant.

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In addition, while the specification sets forth a few specific examples wherein argon was used as a part of the process, there does not appear any intent to claim a process wherein the single process step is the use of argon, i.e. that argon was a critical feature to the retinoid compositions being examined. It is noted that Applicant's listing of the page numbers wherein various embodiments of the claimed invention may be found is not persuasive either of Applicant's intent to file or of written description since the test for both is not when (or if) each individual embodiment was set forth but when the invention (or inventions) as a whole was conveyed.

Thus, there does not appear to be any objective evidence that Applicant originally intended to claim the instant process and the instant claims are now directed to a completely different invention than Applicant originally intended to claim.

In view of the objections to the pending claims set forth above, no claims may be allowed at this time.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to the Group 1600 fax machine at 703/308-4556. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30; November 15 1989.

Any inquiry concerning this Office Action or any earlier Office Actions in this application should be directed to Dr. Gary E. Hollinden whose telephone number is 703/308-4521. Dr. Hollinden's office hours are from 6:30 am to 3:00 pm on Monday through Friday.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703/308-1235.

A handwritten signature in black ink, appearing to read 'G. E. Hollinden', is positioned above the printed name.

**Gary E. Hollinden, Ph.D.**

**Primary Examiner**

**Group 1600**